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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/052,193	01/17/2002	Stephen Jenkinson	PC10963A	8682

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PFIZER INC  
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NEW YORK, NY 10017-5612

EXAMINER

HUI, SAN MING R

ART UNIT	PAPER NUMBER
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1617

DATE MAILED: 06/18/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application N .

.10/052,193

Applicant(s)

JENKINSON ET AL.

Examiner

San-ming Hui

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 01 April 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,3,6,8 and 9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3,6,8 and 9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5,6.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

### **DETAILED ACTION**

The instant application claims the benefit of 60/270,641. this application also claims the benefits of Foreign Application GB 0101223.6.

### ***Election/Restrictions***

Applicant's election without traverse of Group I, claims 1-3 and 6-11, in Paper No. 4 is acknowledged.

Applicant's amendments filed April 1, 2003 have been entered. The cancellation of claims 2, 4, 5, 7, and 10-13 in amendments filed April 1, 2003 is acknowledged.

Claims 1, 3, 6, 8, and 9 are pending.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1, 3, 6, 8, and 9 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The written description requirement is established by 35 U.S.C. 112, first paragraph which states that the: "*specification shall contain a written description of the invention. . .[emphasis added].*" The written

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description requirement has been well established and characterized in the case law. A specification must convey to one of skill in the art that "as of the filing date sought, [the inventor] was in possession of the invention." See *Vas Cath v. Mahurkar* 935 F.2d 1555, 1560 19 USPQ2d 1111, 1117 (Fed. Cir. 1991). Applicant may show that he is in "possession" of the invention claimed by describing the invention with all of its claimed limitations "by such descriptive means as words, structures, figures, diagrams, formulas, etc., that fully set forth the claimed invention." See *Lockwood v. American Airlines Inc.* 107 F.3d 1565, 1572, 41 USPQ2d 1961, 1966 (Fed. Cir. 1997).

The claims are drawn to a selective histamine-4 antagonist, which is 10-fold more selective to histamine H<sub>4</sub> receptor than to histamine-3 receptor, and its combination with histamine 1 antagonist. However, these selective histamine H<sub>4</sub> antagonist are not described in any way in the instant specification except for their functional limitations recited. These are genus claims that encompass a wide array of molecules. The specification fails to disclose any structure of these compounds, nor does it provide any teachings as to how the structures of these compounds relate to their function. Thus, the specification does not describe the complete structure of any species. Neither does the specification describe a representative number of species in terms of partial structure and relevant identifying characteristics. Absent of such teachings and guidance as to the structure-function relationship of these molecules, the specification does not describe the claimed selective histamine H<sub>4</sub> antagonist compounds in such full, clear, concise and exact terms so as to indicate that Applicant had possession of these molecules at the time of filing of the present application.

Examiner notes that the instant specification merely discloses a screening method to identify the herein claimed selective histamine H<sub>4</sub> antagonists, not the selective histamine H<sub>4</sub> antagonists themselves. Thus, the written description requirement has not been satisfied.

Claims 1, 3, 6, 8, and 9 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The instant specification fails to disclose information that enables one of skilled in the art to make the instant invention. As stated above, the instant claims and specification merely disclose the herein histamine H<sub>4</sub> antagonist in terms of functional limitations (i.e., having 10-fold of selective for the histamine H<sub>4</sub> receptor as compared to the histamine H<sub>3</sub> receptor). Attention is directed to *General Electric Company v. Wabash Appliance Corporation et al* 37 USPQ 466 (US 1938), at 469, speaking to functional language at the point of novelty as herein employed: "the vice of a functional claim exists not only when a claims is "wholly" functional, if that is ever true, but when the inventor is painstaking when he recites what has already been seen, and then uses conveniently functional language at the exact point of novelty". Functional language at the point of novelty, as herein employed by Applicants, is further admonished in *University of California v. Eli Lilly and Co.* 43 USPQ2d 1398 (CAFC 1997) at 1406: stating this usage does "little more than outlin[e] goals appellants hope the recited

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invention achieves and the problems the invention will hopefully ameliorate”.

Applicants functional language at the point of novelty fails to meet the requirements set forth under 35 USC 112, first paragraph. Claims employing functional language at the point of novelty, such as Applicants', neither provide those elements required to practice the inventions, nor “inform the public during the life of the patent of the limits of the monopoly asserted” *General Electric Company v. Wabash Appliance Corporation et supra*, at 468. Claims thus constructed provide no guidance as to structure of specific agents, levels for activities related to the anti-H<sub>4</sub> activities, or provide notice for those practicing in the art, limits of protection. Simply stated, the presented claims are an invitation to experiment, not reciting a specific medicament regimen useful for practicing the instant invention. In addition, in a recent court ruling in *University of Rochester v. G.D. Searle & Co. Inc.*, W.D. N.Y., No. 00-CV-6161L, 3/5/03, regard to using merely functional language to describe an invention, further stated that in order “to practice the invention claimed in the patent, a person of ordinary skill in the art could have to engage in undue experimentation, with no assurance of success.” Such functional limitations essentially call for the use of trial and error to attempt to find a compound that will selectively bind to histamine H<sub>4</sub> receptor, which is the compound claimed by the instant application. “[p]atent protection is granted in return for an enabling disclosure of an invention, not for vague intimations of general ideas that may or may not be workable. Tossing out the germ of an idea does not constitute enabling disclosure.” *Genetech*, 108 F.3d at 1366 (quoting *Brenner v. Manson*, 383 U.S. 519, 536 (1966) (stating, in context of the utility requirement, that “a patent is not a hunting license. It is not a

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reward for the search, but compensation for its successful conclusion")). Therefore, absent sufficient and reasonable detail provided by the applicant, the instant claims fail to comply with the enablement requirement set forth in. 35 USC 112, first paragraph.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to San-ming Hui whose telephone number is (703) 305-1002. The examiner can normally be reached on Mon 9:00 to 1:00, Tu - Fri from 9:00 to 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan, PhD., can be reached on (703) 305-1877. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-4556 for regular communications and (703) 308-4556 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.



San-ming Hui  
Patent Examiner  
Art Unit 1617  
June 13, 2003